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INDIANAPOLIS, IN 46204-2079

EXAMINER

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The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 09/633,937  
Filing Date: August 08, 2000  
Appellant(s): EGAN, PATRICK

AUG 08 2007

**GROUP 3600**

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Patrick Egan  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/24/2007 appealing from the Office action mailed 6/4/2004.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,743,056	Balla-Goddard	04-1998
5,771,645	Porter	06-1998

**(9) Grounds of Rejection**

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The following ground(s) of rejection are applicable to the appealed claims:

Claims 24-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balla-Goddard (US 5,743,056).

Balla-Goddard discloses a building panel structures comprising a first, exterior, a second, interior facing sheets of generally rigid material 56, and having a first, a second, thickness, and a first, a second sheet perimeter, respectively; U-shaped brackets 200 serve as framing struts and being located between the first and second sheets and having struts thickness to define a panel volume between the first, second sheets, and framing struts; a layer of polymeric in-situ foam core 58 comprising polyurethane located in and substantially filling the panel volume, a sheet of drywall 52 having a drywall thickness and adjacent the interior facing sheet 56, the drywall having an interior surface, a trim piece 216, a jamb member 33, service ducts 103 are located between the plaster board or drywall 52 and the panel 16 for electricity cables, telephone lines, service pipes and/or gas pipes, a window opening (col. 7, lines 40-43, 65-66). The jamb member thickness 33 is substantially equal to the sum of the overall panel thickness and the drywall thickness, such that the jamb is substantially flush therewith for the trim piece to be mounted flush across the jamb and drywall without the use of furring (see Fig. 4). The panel has a first vertical side edge having a male projection member 72 adapted to project into a corresponding female reception member 74 on an adjacent panel (Figs. 1-9). Balla-Goddard does the basic structures for the building structures as stated but does not teach specifically the overall panel thickness between approximately 3 ¾ and 4 ¼ inches, the struts having an actual cross-sectional dimensioning about 1 ½

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by 3 3/16", and the thermal insulation R-value through a foam containing portion of the thickness of at least 20, the first, second sheets are each made from 7/16 thick OSB, and drywall has a thickness of 1/2". It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the desirable thickness of the panel, strut cross section thickness and the R value insulation to accommodate the opening thickness is considered as an obvious design choice based on desired use. Furthermore, applicant has not disclosed the criticality of this feature.

With regards to claims 32, 40, 43, and 50:

Balla-Goddard teaches the structural elements for the wall panel except for the struts are wooden. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have wooden struts, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. The motivation for doing so would have been to provide lightweight wall structure and cost less than metal material. Balla- Goddard teaches a window opening between panels 32 and 30 forming the base and the top of the opening and panels 26 and 28, brackets 208 are secured to the panels around the outside opening and a wooden window frame 34 (col. 8, lines 7-9).

Claim 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,743,056 to Balla-Goddard et al. in view of US Patent No. 5,771,645 to Porter

Balla-Goddard teaches the structural elements for the building wall panel as stated

except for at least one electrical box located between the first sheet and the second sheet. Porter teaches electrical access in structural insulated foam core panels including electrical box 42 located between first 12 and second 14 sheets (see fig. 1 ). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Balla-Goddard with Porter for the electrical box connected to the service duct 103 taught by Balla-Goddard (col. 7, lines 41-42). The motivation for doing so would have been to provide electrical outlet for occupant usage. Furthermore, having at least one electrical box located between the first sheet and the second sheet is well known and old because every residential or commercial building equipped with electrical outlets.

#### **(10) Response to Argument**

Appellant argues: Balla- Goddard fails to disclose, teach, or suggest the pre-fabricated wall panel of claim 24 comprising "an overall panel thickness being between approximately 33/4 inches and 4 1/4 inches." Appellant also asserts the reference fails to disclose, teach, or suggest the pre-fabricated wall panel comprising "said jamb having a jamb thickness..., wherein said jamb thickness is substantially equal to the sum of the overall panel thickness and the drywall thickness, such that the jamb is substantially flush therewith for the trim piece to be mounted flush across the jamb and drywall without the use of furring." Appellant asserts contrary to the office opinion that a specific range of thickness would not have been obvious to one having ordinary skill in the art at the time of the invention was made to have such overall panel thickness between approximately 33/4 and 41/4 inches. While the examiner agrees the prior art does not

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specifically show such the overall thickness panel; the applicant's specification does not provide any criticality of this feature. Specifically, in page 6, lines 16-end of the applicant specification states "*...provided from a window vendor. The window has window jambs 42 having a thickness  $T_s$ . Many off the shelf window jambs have a thickness  $T_5$  of  $4 \frac{9}{16}$  inches as a standard dimension. With the present invention having an overall panel thickness of approximately 4 inches (plus or minus a quarter inch), and more preferably  $4 \frac{1}{16}$  inches in the most preferred form, when the drywall sheet 43 is secured to the interior sheet 25, the overall thickness of the wall panel in combination with the  $\frac{1}{2}$  inch drywall is either exactly  $4 \frac{9}{16}$  inches thick, or closely approaches that dimension. In this way, with a finished assembly, the window jamb 42 is flush with the exterior of surface exterior sheet 23 and with the interior surface of the drywall 43.*" To differentiate the well known standard dimension, the applicant preferred to have the overall thickness of  $4 \frac{1}{16}$ "inches instead of  $4 \frac{9}{16}$ "inches. Therefore the claim would have been obvious because a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Appellant argues "Balla-Goddard fails to disclose, teach, or suggest the panel has a jamb thickness substantially equal to the sum of the overall panel thickness and the drywall thickness, such that the jamb is substantially flush therewith for the trim piece to be mounted flush across the jamb and drywall without the use of furring. The June 4, 2004 Office Action refers to Balla-Goddard's plasterboard strips 33 as a jamb member. However, it is respectfully urged that plasterboard strips 33 do not qualify as a jamb

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member. A person of ordinary skill in the art will understand that the term "jamb" defines the upright sides of an aperture, as a doorway, window, or fireplace, and supporting the lintel, entablature, or mantel. Further, the person of ordinary skill in the art should appreciate the term "jamb" as "an upright piece or surface forming the side of an opening (as for a door, window, or fireplace). As shown in Fig. 4 of Balla-Goddard, plasterboard strips 33 do not provide an opening for a door, window, or fireplace. Indeed, strips 33 do not receive window 212 at all. Rather, window 212 is positioned within brick facing 36 and cavity barrier 214 so as to be secured to L-shaped brackets 208, all of which are outside and in front of the area defined by strips 33. Further, plasterboard strips 33 do not support lintel 222. Rather, L-shaped brackets 208 support lintel 222. Moreover, plasterboard strips 33 appear to be more like furring rather than any jamb or jamb member. On the other hand, the present application discloses in Fig. 6 an example where a door 45 is received within a doorjamb 46 and discloses in Fig. 7 another example where a window 41 is received and supported within a window jamb 42. As such, Balla-Goddard would have failed to render obvious the pre-fabricated wall panel comprising "said jamb having a jamb thickness..., wherein said jamb thickness is substantially equal to the sum of said overall panel thickness and said drywall thickness, such that said jamb is substantially flush therewith for said trim piece to be mounted flush across the jamb and drywall without the use of furring."

Examiner does not agree the applicant's argument because the prior art Balla-Goddard clearly shows a jamb member 33 has a thickness substantially equal to the sum of the overall panel thickness (see Fig. 4); Although the jamb member 33 does not function as



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an upright piece or surface forming the side of an opening (as for a door, window, or fireplace); however the claim does not require to have such functions and examiner believes it would capable of performing the similar functions.

Appellant argues: "Balla-Goddard does not disclose any electrical box located between first and second facing sheets". Examiner does not agree with the applicant's argument because the prior art teaches the electricity cable conduits 103 are located between the plasterboard 52 and the panel 16 for electricity cables (see col. 7, lines 40-42) therefore it would have been obvious to one having ordinary skill in the art to put electrical box at any convenient place for desirable application (light, TV, computer, etc.). It would have obvious because the electrical box located in between the wall sheets is well known in every residential or commercial building in order to attach with electrical outlets.

Appellant argues: "Fig. 4 of Balla- Goddard shows that window 212 is mounted within bricks 36 and cavity barrier 214 by use of L- shaped-brackets 208. As such, window 212 is not mounted within panels 30, 32. Further, Balla- Goddard does not disclose any window jamb having a thickness of  $4 \frac{9}{16}$  inches and being mounted in substantially flush alignment with said overall panel thickness. No evidence of a reason, suggestion, or motivation for modifying Balla-Goddard and thus not have rendered obvious the pre-fabricated wall panel comprising "a window mounted in said window opening is cut in said first sheet and said second sheet and partially defined by strut members around a perimeter thereof, said window having window jambs having a thickness of  $4 \frac{9}{16}$  inches and being mounted in substantially flush alignment with said overall panel thickness." Examiner does not agree with the applicant's argument because in Fig. 1 of

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Prior Art shows window opening between panels for installing a window frame and with regard to the argued limitation of a jamb that having a thickness of 4 9/16 inches (see above for examiner's rebuttals).

Appellant argues "Balla-Goddard does not disclose the thermal insulation R-value for its panel, much less an R-value of at least 20." Applicant does not provide any criticality of this feature therefore examiner considers it would have been obvious to one having an ordinary skill in the art to have such R-value for insulation for regional application.


With respect to the declaration of Mr. Patrick Egan filed on 2/11/03, alleging commercial success, the declaration falls short of providing the commercial success is directly attributed to the specific dimensions found in the claim. More over there is no delimitative showing market share or success based on non-advertisement.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Chi Q. Nguyen

Conferees:

Richard Chilcot, SPE

Meredith Petravick 

  
RICHARD E. CHILCOT, JR.  
SUPERVISORY PATENT EXAMINER